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| APPLICATION NO.           | FILING DATE                                    | FIRST NAMED INVENTOR | . ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|--|----------------------|-----------------------|------------------|
| 10/663,538                | 09/15/2003                                     | Peter S. Lu          | 020054-000211US       | 5609             |
|                           | 7590 10/17/200 <sup>-</sup><br>AND TOWNSEND AN |                      | EXAM                  | INER             |
| TWO EMBAR                 | CADERO CENTER                                  |                      | BUNNER, E             | RIDGET E         |
| EIGHTH FLOO<br>SAN FRANCI | OR<br>SCO, CA 94111-3834                       |                      | ART UNIT              | PAPER NUMBER     |
|                           | •  |                      | 1647                  |                  |
|                           |  |                      | _                     |                  |
|                           |  |                      | MAIL DATE             | DELIVERY MODE    |
|                           |  |                      | 10/17/2007            | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                                       |  | T   |   |
|---------------------------------------|--|---|---|
| •                                     |  | Application No.   | Applicant(s)  |
|                                       | Office Author O  | 10/663,538  | LU ET AL.   |
|                                       | Office Action Summary  | Examiner  | Art Unit  |
|                                       |  | Bridget E. Bunner   | 1647  |
| Period fo                             | The MAILING DATE of this communication app<br>or Reply   | pears on the cover sheet with   | the correspondence address  |
| WHIC - Exte after - If NC - Failu Any | ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.1: SIX (6) MONTHS from the mailing date of this communication. O period for reply is specified above, the maximum statutory period verse to reply within the set or extended period for reply will, by statute reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b). | ATE OF THIS COMMUNICA 36(a). In no event, however, may a reply vill apply and will expire SIX (6) MONTH: cause the application to become ABAN | TION.  y be timely filed  S from the mailing date of this communication.  DONED (35 U.S.C. 8 133) |
| Status                                |  |   |   |
| 1)                                    | Responsive to communication(s) filed on 02 At  | ugust 2007.   |   |
|                                       |  | action is non-final.  |   |
| 3)                                    | Since this application is in condition for allowar   | nce except for formal matters   | s, prosecution as to the merits is  |
|                                       | closed in accordance with the practice under E   | x parte Quayle, 1935 C.D. 1   | 1, 453 O.G. 213.  |
| Dispositi                             | on of Claims   |   |   |
| 5)□<br>6)⊠<br>7)□                     | Claim(s) <u>1-20</u> is/are pending in the application.  4a) Of the above claim(s) <u>7,13,14 and 18-20</u> is/ Claim(s) is/are allowed.  Claim(s) <u>1-6,8-12 and 15-17</u> is/are rejected.  Claim(s) is/are objected to.  Claim(s) <u>1-20</u> are subject to restriction and/or expressions.   | are withdrawn from consider   | ration.   |
| Applicati                             | on Papers  |   |   |
| 10)🖾                                  | The specification is objected to by the Examiner The drawing(s) filed on 14 January 2004 is/are: Applicant may not request that any objection to the o Replacement drawing sheet(s) including the correcti The oath or declaration is objected to by the Examination   | a) $\boxtimes$ accepted or b) $\square$ objedrawing(s) be held in abeyance. on is required if the drawing(s) i                                | See 37 CFR 1.85(a). is objected to. See 37 CFR 1.121(d).  |
| Priority u                            | nder 35 U.S.C. § 119   |   | •   |
| 12) <u></u> / a)[                     | Acknowledgment is made of a claim for foreign  All b) Some * c) None of:  1. Certified copies of the priority documents  2. Certified copies of the priority documents  3. Copies of the certified copies of the priori application from the International Bureau ee the attached detailed Office action for a list of   | have been received. have been received in Appl ty documents have been rec (PCT Rule 17.2(a)).   | ication No ceived in this National Stage  |
| Attachment                            | •  | <b>"□</b>   |   |
| 2) 🔲 Notice<br>3) 🔲 Inform            | e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO/SB/08) No(s)/Mail Date   | 4) ☐ Interview Sumr<br>Paper No(s)/Ma<br>5) ☐ Notice of Inform<br>6) ☒ Other: <i>Appendi</i>  | ail Date<br>nal Patent Application  |

#### **DETAILED ACTION**

#### Status of Application, Amendments and/or Claims

The amendment of 02 August 2007 has been entered in full. Claims 1, 2, 4, 6, 15 are amended.

This application contains claims 7, 13, 14, and 18-20 drawn to an invention nonelected with traverse in the reply filed on 20 November 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-6, 8-12, and 15-17 are under consideration in the instant application.

#### Withdrawn Objections and/or Rejections

- 1. The objections to the specification at pages 4-5 of the previous Office Action (02 February 2007) are *withdrawn in part* in view of the amended specification (02 August 2007). Please see section on Specification, below.
- 2. The objections to claims 1-4, 6, and 15 at page 5 of the previous Office Action (02 February 2007) are *withdrawn in part* in view of the amended claims (02 August 2007). Please see section on Claim Objections, below.
- 3. The rejection of claims 1-3, 6, 8-12, and 15-17 under 35 U.S.C. § 112, first paragraph (scope of enablement) for recitation of nucleic acid variants as set forth at pages 12-14 of the previous Office Action (02 February 2007) is *withdrawn* in view of the amended claims (02 August 2007).

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4. The rejection of claims 1-6, 8-12, and 15-17 under 35 U.S.C. § 112, first paragraph (written description) as set forth at pages 18-20 of the previous Office Action (02 February 2007) is *withdrawn* in view of the amended claims (02 August 2007).

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- 5. The rejection of claim 5 under 35 U.S.C. § 112, first paragraph (Deposit Rules) as set forth at pages 20-22 of the previous Office Action (02 February 2007) is *withdrawn* in view of Applicant's declaration of 02 August 2007.
- 6. The rejection of claims 1-6, 8-12, and 15-17 under 35 U.S.C. § 112, second paragraph as set forth at page 22 of the previous Office Action (02 February 2007) is *withdrawn* in view of the amended claims (02 August 2007).
- 7. The rejection of claims 1, 15-16 under 36 U.S.C. § 102(b) as set forth at pages 22-23 of the previous Office Action (02 February 2007) is *withdrawn* in view of the amended claims (02 August 2007).
- 8. The rejection of claims 8-12 and 17 under 35 U.S.C. § 103(a) as set forth at pages 23-25 of the previous Office Action (02 February 2007) is *withdrawn* in view of the amended claims (02 August 2007).

### Sequence Compliance

The Applicant's response to the Notice to Comply with Sequence Listing Requirements under 37 CFR §1.821 (02 August 2007 has been considered and is found persuasive. Therefore, the requirements set forth in the Notice to Comply (02 February 2007) are *withdrawn*.

### Specification

9. The disclosure is objected to because of the following informalities:

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9a. The specification refers to Figures which were deleted in the amendment of 16 January

2004. Please see, for example, pages 25, 45, 47, 68, 113, 114, 115, 125. The basis for this

objection is set forth at page 4 of the previous Office Action (02 February 2007).

It is noted that at page 1 of the response of 02 August 2007, Applicant indicates that

Applicant is reconsidering re-introducing these figures into the application.

Appropriate correction is required.

Claim Objections

10. Claims 4, 6 and 15 are objected to because of the following informalities:

10a. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for

failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form. Claim 1 (upon which claim 4 depends) and claim 4 both recite a

polynucleotide encoding SEQ ID NO: 2.

10b. Claims 6 and 15 use the acronym "CLASP-2" without first defining what they represent

in the independent claims. While the claims can reference acronyms, the material presented by

the acronym must be clearly set forth at the first use of the acronym. The basis for this objection

is set forth at page 5 of the previous Office Action (02 February 2007).

Appropriate correction is required.

Claim Rejections - 35 USC § 101 and § 112, first paragraph

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and

requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-6, 8-12, and 15-17 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility. Novel biological molecules lack well established utility and must undergo extensive experimentation. The basis for this rejection is set forth at pages 5-11 of the previous Office Action (02 February 2007).

Applicant's arguments (02 August 2007), as they pertain to the rejections have been fully considered but are not deemed to be persuasive for the following reasons.

(i) Applicant asserts at page 2 of the Response that knowledge of how an invention works is not needed for patentability. Applicant indicates that it is enough for Applicants to have identified that CLASP-2 is involved in such processes, and to have identified the disease states that ultimately correlate with CLASP-2 dysfunction.

Applicant's arguments have been fully considered but are not found to be persuasive. Although knowledge of how an invention works is not needed for patentability, the invention must be supported by either a credible, specific, and substantial asserted utility or a well established utility. In the instant application, the specification does not disclose any methods or working examples the indicate the CLASP-2 polynucleotide and polypeptide are involved in any processes, such as T cell activation, regulation of T cell and B cell interactions, and in the organization, establishment, and maintenance of the "immunological synapse" (including signal transduction, cytoskeletal interactions, and membrane organization) (pg 22, lines 1-7; pg 21, lines 1-5). Since significant further research would be required of the skilled artisan to determine

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how the claimed polypeptide is involved with the above-mentioned activities, the asserted utilities are not substantial. Since the utility is not presented in mature form and significant further research is required, the utility is not substantial.

The specification also does not disclose any disease states associated with a mutated, deleted, or translocated CLASP-2 gene (SEQ ID NO: 1) or protein (SEQ ID NO: 2). The specification does not disclose which disorders are associated with altered levels of the CLASP-2 gene or protein. Significant further experimentation would be required of the skilled artisan to identify individuals with such a disease. Since this asserted utility is also not present in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial.

(ii) At page 3 of the Response, Applicant argues that post-filing date work has confirmed the involvement of CLASP-2 in immune response, especially T-cell activation. Applicant indicates that multiple publications have shown that CLASP-2 (called Zizimin 1 or DOCK9) interacts with and activates a rho-family GTPase called cdc42 (Meller et al. 2002). Applicant also submits that activated cdc42 promotes cytoskeletal polarization of T cells in response to contact with antigen-presenting cells (Stowers et al. 1995). Applicant concludes that the role of CLASP-2 in promoting T cell activation is of clear relevance to immunological diseases such as immune system disorders, allergic reactions, organ rejection, etc.

Applicant's arguments have been fully considered but are not found to be persuasive.

Applicant indicates that CLASP-2 is also known as Zizimin 1 or DOCK9, which has been shown to interact with cdc42. However, according to the Examiner's sequence search of 18 December 2006, the CLASP-2 amino acid sequence of SEQ ID NO: 2 is only 94.0% identical to

Zizimin1/DOCK9 (see sequence alignment attached to the instant Office Action as Appendix A). Additionally, the CLASP-2 nucleic acid sequence of SEQ ID NO: 1 is only 73.8% identical to the Zizimin1 nucleic acid sequence (see sequence alignment attached to the instant Office Action as Appendix B). Thus, it is not clear how Applicant has concluded that CLASP-2 is Zizimin1/DOCK9. From the sequence search performed by the PTO, it seems that CLASP-2 and Zizimin1/DOCK9 are different proteins.

Additionally, although the specification of the instant application teaches that CLASP-2 expression levels decrease at 1 hour, 2 hours, and 4 hours after T cell activation (pg 125, lines 4-14), it cannot be determined if this decrease is a significant difference as compared to T-cells that have not been activated. If the decrease in CLASP-2 expression is not significant between the two cell types, then this utility is not specific because the skilled artisan would not be able to distinguish activated T-cells from inactivated T-cells. Since this asserted utility is also not presented in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial. Applicant is encouraged to submit any evidence under 37 C.F.R. 1.132 that would indicate a significant difference between the expression of CLASP-2 in activated and inactivated T-cells.

(iii) At the bottom of page 3 of the Response, Applicant contends that the very striking similarity between CLASP-1 and CLASP-2 (Figure 5) imparts substantial credibility to Applicant's assertion that CLASP-2 (like CLASP-1) is involved in T-cell activation. Applicant asserts that there is no basis for the Examiner to argue to the contrary or to assert that Applicant's disclosed utility of CLASP-2 is neither specific nor substantial.

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Applicant's arguments have been fully considered but are not found to be persuasive. The truth, or credibility, of the assertion of utility has not been questioned. Rather, the rejection sets forth that the assertion of utility is not specific or substantial. In the previous Office Action of 02 February 2007, the Examiner made a prima facie showing that the claimed invention lacks utility and provided sufficient evidentiary basis for factual assumptions relied upon in establishing the prima facie showing. The assertion that the disclosed CLASP-2 polynucleotide has biological activities similar to protein family members having a role in T cell activation is not specific or substantial in the absence of supporting evidence, because the relevant literature reports numerous examples of polypeptide families wherein individual members have distinct, and even opposite, biological activities. For example, Tischer et al. (U.S. Patent 5,194,596) establishes that VEGF (a member of the PDGF, or platelet-derived growth factor, family) is mitogenic for vascular endothelial cells but not for vascular smooth muscle cells, which is opposite to the mitogenic activity of naturally occurring PDGF which is mitogenic for vascular smooth muscle cells but not for vascular endothelial cells (column 2, line 46 to column 3, line 2). The differences between PDGF and VEGF are also seen in vivo, wherein endothelial-pericyte associations in the eye are disrupted by intraocular administration of PDGF but accelerated by intraocular administration of VEGF (Benjamin et al., 1998, Development 125:1591-1598; see Abstract and pp. 1594-1596). Vukicevic et al. (1996, PNAS USA 93:9021-9026) disclose that OP-1, a member of the TGF- $\beta$  family of proteins, has the ability to induce metanephrogenesis, whereas closely related TGF-\$\beta\$ family members BMP-2 and TGF-\$\beta\$1 had no effect on metanephrogenesis under identical conditions (p. 9023, paragraph bridging columns 1-2). See also Massague, who reviews other members of the TGF-β family (1987, Cell 49:437-8, esp. p.

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438, column 1, second full paragraph to the end). Similarly, PTH and PTHrP are two structurally closely related proteins which can have opposite effects on bone resorption (Pilbeam et al., 1993, Bone 14:717-720; see p. 717, second paragraph of Introduction). Finally, Kopchick et al. (U.S. Patent 5,350,836) disclose several antagonists of vertebrate growth hormone that differ from naturally occurring growth hormone by a single amino acid (column 2, lines 37-48). Generally, the art acknowledges that function cannot be predicted based solely on structural similarity to a protein found in the sequence databases. For example, Skolnick et al. (2000, Trends in Biotech. 18:34-39) state that knowing the protein structure by itself is insufficient to annotate a number of functional classes, and is also insufficient for annotating the specific details of protein function (see Box 2, p. 36). Similarly, Bork (2000, Genome Research 10:398-400) states that the error rate of functional annotations in the sequence database is considerable, making it even more difficult to infer correct function from a structural comparison of a new sequence with a sequence database (see especially p. 399). Such concerns are also echoed by Doerks et al. (1998, Trends in Genetics 14:248-250) who state that (1) functional information is only partially annotated in the database, ignoring multi functionality, resulting in underpredictions of functionality of a new protein and (2) overpredictions of functionality occur because structural similarity often does not necessarily coincide with functional similarity. Smith et al. (1997, Nature Biotechnology 15:1222-1223) remark that there are numerous cases in which proteins having very different functions share structural similarity due to evolution from a common ancestral gene. Brenner (1999, Trends in Genetics 15:132-133) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, then most homologs must have different

substantial utility of T cell activation.

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molecular and cellular functions. Bork et al. (1996, Trends in Genetics 12:425-427) add that the software robots that assign functions to new proteins often assign a function to a whole new protein based on structural similarity of a small domain of the new protein to a small domain of a known protein. Such questionable interpretations are written into the sequence database and are then considered facts. Thus, the specification fails to support the asserted credible, specific and

(iv) At page 4 of the Response, Applicant argues that the Office Action's allegation that it is necessary to completely characterize the nature of CLASP-2's involvement in T cell activation is incorrect. Applicant adds that inhibitors can be identified by the relatively simple *in vitro* binding assays disclosed in the specification. Applicant states that it is not necessary to have a complete understanding of underlying mechanisms to identify inhibitors of CLASP-2 activity, nor to perform trials of such identified inhibitors in cellular or animal models for activity in protecting against cell death. Applicant indicates that usefulness in patent law, and in particular in the context of pharmaceutical inventions, necessarily includes the expectation of further research and development and cites *in re Brana*, 34 USPQ2d 1436 (Fed. Cir. 1995).

Applicant's arguments have been fully considered but are not found to be persuasive.

The asserted utilities put forth by Applicant and the specification of the instant application are credible, but not specific or substantial. The asserted utility of screening for activators/inhibitors can be performed with any polypeptide. The specification also discloses nothing specific or substantial about the ligands, agonists/antagonists, and binding proteins that are identified by these methods. Substantial further research is required to determine the usefulness of agonists,

antagonists isolated in this manner. Since these asserted utilities are also not present in mature form, so that they could be readily used in a real world sense, the asserted utilities are not substantial. Furthermore, the fact patterns of the case cited by the Applicant and of the instant rejection are significantly different, and the court decision is not binding with regard to the instant rejection. Although, as discussed in re Brana, that pharmaceutical inventions necessarily include further research and development, it is clear from the instant specification that the polypeptide described therein is what is termed an "orphan protein" in the art. This is a protein whose cDNA has been isolated because of its similarity to known proteins. There is little doubt that, after complete characterization, this DNA and protein, may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken, Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in Brenner v. Manson, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. §101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility.

12. Claims 1-6, 8-12, and 15-17 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial

asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The basis for this rejection is set forth at pages 11-12 of the previous Office Action (02 February 2007).

Applicant's arguments (02 August 2007), as they pertain to the rejections have been fully considered but are not deemed to be persuasive for the following reasons.

Applicant states that a specific and substantial asserted utility, as described above.

Specifically, since Applicant has not provided evidence to demonstrate that the CLASP-2

polynucleotide and polypeptide have a specific and substantial asserted utility or a well established utility, one skilled in the art would not know how to use the claimed invention. It is noted that the instant specification is required to teach one skilled in the art how to make and use the polypeptide encoded by the claimed polynucleotides.

13. However, even if the claimed invention is eventually deemed to have a credible, specific and substantial asserted utility or a well established utility, claims 10-12 would remain rejected under 35 U.S.C. § 112, first paragraph. The basis for this issue is set forth at pages 14-17 of the previous Office Action (02 February 2007) and is reiterated herein below.

The Examiner has interpreted claims 10-12 as reading on isolated host cells, as well as host cells in the context of a multicellular, transgenic organism and host cells intended for gene therapy. The specification of the instant application teaches that CLASP-2 gene can be expressed in transgenic animals and any technique known in the art may be used to introduce a CLASP-2 transgene into animals to produce the founder lines of transgenic animals (pg 66-67). However, there are no methods or working examples disclosed in the instant application whereby

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a multicellular animal with the incorporated CLASP-2 gene of SEQ ID NO: 1 is demonstrated to express the CLASP-2 peptide. There are also no methods or working examples in the specification indicating that a multicellular animal has CLASP-2 "knocked out". The unpredictability of the art is very high with regards to making transgenic animals. For example, Wang et al. (Nuc. Acids Res. 27: 4609-4618, 1999; pg 4617) surveyed gene expression in transgenic animals and found in each experimental animal with a single "knock-in" gene, multiple changes in genes and protein products, often many of which were unrelated to the original gene. Likewise, Kaufman et al (Blood 94: 3178-3184, 1999) found transgene expression levels in their transfected animals varied from "full" (9 %) to "intermediate" to "none" due to factors such as "vector poisoning" and spontaneous structural rearrangements (pg 3180, col 1, 2<sup>nd</sup> full paragraph; pg 3182-3183). Additionally, for example, the specification discloses that two possible techniques used to introduce a CLASP-2 transgene into animals include pronuclear microinjection and gene targeting in embryonic stem cells (pg 66, lines 28-31). However, the literature teaches that the production of transgenic animals by microinjection of embryos suffers from a number of limitations, such as the extremely low frequency of integration events and the random integration of the transgene into the genome which may disrupt or interfere with critical endogenous gene expression (Wigley et al. Reprod Fert Dev 6: 585-588, 1994). The inclusion of sequences that allow for homologous recombination between the transgenic vector and the host cell's genome does not overcome these problems, as homologous recombination events are even rarer than random events. Therefore, in view of the extremely low frequency of both targeted and non-targeted homologous recombination events in microinjected embryos, it would have required undue experimentation for the skilled artisan to have made any and all transgenic

non-human animals according to the instant invention. Furthermore, regarding gene targeting in embryonic stem cells, the specification does not provide guidance for identifying and isolating embryonic stem cells or for identifying other embryonal cells which are capable of contributing to the germline of any animal. At the time of filing, Campbell et al. teaches that, "in species other than the mouse the isolation of ES cells has proved more difficult. There are reports of ES-like cell lines in a number of species...However, as yet there are not reports of any cell lines which contribute to the germ line in any species other than mouse" (Campbell et al. Theriology 47(1): 63-72, 1997; see pg 65, 2<sup>nd</sup> paragraph). Thus, based on the art recognized unpredictability of isolating and using embryonic stem cells or other embryonal cells from animals other than mice to produce transgenic animals, and in view of the lack of guidance provided by the specification for identifying and isolating embryonal cells which can contribute to the germ line of any non-human mammal other than the mouse, such as dogs or cows, the skilled artisan would not have had a reasonable expectation of success in generating any and all non-human transgenic animals using ES cell technology.

The specification also discloses that nucleic acids encoding the CLASP-2 polypeptide can be used for gene therapy (pg 62-65). However, the specification does not teach any methods or working examples that indicate a CLASP-2 nucleic acid is introduced and expressed in a cell for therapeutic purposes. The disclosure in the specification is merely an invitation to the artisan to use the current invention as a starting point for further experimentation. For example, the specification does not teach what type of vector would introduce the CLASP-2 nucleic acid into the cell or in what quantity and duration. Relevant literature teaches that since 1990, about 3500 patients have been treated via gene therapy and although some evidence of gene transfer has

been seen, it has generally been inadequate for a meaningful clinical response (Phillips, A., J Pharm Pharmacology 53: 1169-1174, 2001; abstract). Additionally, the major challenge to gene therapy is to deliver DNA to the target tissues and to transport it to the cell nucleus to enable the required protein to be expressed (Phillips, A.; pg 1170, ¶ 1). Phillips also states that the problem with gene therapy is two-fold: 1) a system must designed to deliver DNA to a specific target and to prevent degradation within the body, and 2) an expression system must be built into the DNA construct to allow the target cell to express the protein at therapeutic levels for the desired length of time (pg 1170, ¶ 1). Therefore, undue experimentation would be required of the skilled artisan to introduce and express a CLASP2 nucleic acid into the cell of an organism. Additionally, gene therapy is unpredictable and complex wherein one skilled in the art may not necessarily be able to introduce and express a CLASP-2 nucleic acid in the cell of an organism or be able to produce a CLASP-2 protein in that cell. (Please note that this issue could be overcome by amending the claims to recite, for example, "An isolated host cell...").

Due to the large quantity of experimentation necessary to generate a transgenic animal expressing the CLASP-2 protein and to introduce and express a CLASP-2 nucleic acid in a cell of an organism for therapy; the lack of direction/guidance presented in the specification regarding how to introduce a CLASP-2 nucleic acid in the cell of an organism to be able produce that CLASP-2; the absence of working examples directed to same; the complex nature of the invention; the state of the prior art which establishes the unpredictability of making transgenic animals and of transferring genes into an organism's cells; and the breadth of the claims which fail to recite any structural or functional limitations, undue experimentation would be required of the skilled artisan to make and/or use the claimed invention in its full scope.

#### Conclusion

No claims are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bridget E. Bunner whose telephone number is (571) 272-0881. The examiner can normally be reached on 8:30-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BEB Art Unit 1647 12 October 2007

> BRIDGET E. BUNNER PRIMARY EXAMINER

Bridget C. Bunner

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<!--StartFragment-->RESULT 3
 DOCK9 HUMAN
      DOCK9 HUMAN
                     STANDARD;
                                      PRT: 2069 AA.
      Q9BZ29; Q5JUD4; Q5JUD6; Q5T2Q1; Q5TAN8; Q9BZ25; Q9BZ26; Q9BZ27;
      Q9BZ28; Q9UPU4;
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 DT
      19-OCT-2002, sequence version 2.
      07-MAR-2006, entry version 39.
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 OC
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      Meller N., Irani-Tehrani M., Kiosses W.B., Del Pozo M.A.,
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      Schwartz M.A.;
      "Zizimin1, a novel Cdc42 activator, reveals a new GEF domain for Rho
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      Nat. Cell Biol. 4:639-647(2002).
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      MEDLINE=99397452; PubMed=10470851; DOI=10.1093/dnares/6.3.197;
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      Kikuno R., Nagase T., Ishikawa K., Hirosawa M., Miyajima N.,
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RT
      "Prediction of the coding sequences of unidentified human genes. XIV.
RT
      The complete sequences of 100 new cDNA clones from brain which code
RT
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RL
      DNA Res. 6:197-205(1999).
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      Nakajima D., Okazaki N., Yamakawa H., Kikuno R., Ohara O., Nagase T.;
RT
      "Construction of expression-ready cDNA clones for KIAA genes: manual
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      DNA Res. 9:99-106(2002).
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     PubMed=15057823; DOI=10.1038/nature02379;
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     Dunham A., Matthews L.H., Burton J., Ashurst J.L., Howe K.L.,
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     Ainscough R., Almeida J.P., Ambrose K.D., Andrews D.T.,
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     Harley J.L., Hart E.A., Heath P.D., Howden P.J., Huckle E.J.
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     Sehra H.K., Shownkeen R., Skuce C.D., Smith M., Steward C.A.
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     Wall M., Wallis J.M., West A.P., Whitehead S.L., Willey D.L.,
     Wilming L., Wray P.W., Wright M.W., Young L., Coulson A., Durbin R., Hubbard T., Sulston J.E., Beck S., Bentley D.R., Rogers J., Ross M.T.; "The DNA sequence and analysis of human chromosome 13.";
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      Altschul S.F., Zeeberg B., Buetow K.H., Schaefer C.F., Bhat N.K.,
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      Butterfield Y.S.N., Krzywinski M.I., Skalska U., Smailus D.E.,
      Schnerch A., Schein J.E., Jones S.J.M., Marra M.A.;
      "Generation and initial analysis of more than 15,000 full-length human
RT
RT
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      Proc. Natl. Acad. Sci. U.S.A. 99:16899-16903(2002).
RL
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      MEDLINE=22319137; PubMed=12432077; DOI=10.1242/jcs.00219;
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     Cote J.-F., Vuori K.;
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      "Identification of an evolutionarily conserved superfamily of DOCK180-
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CC
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     -!- SUBUNIT: Interacts preferentially with nucleotide-depleted CDC42.
CC
CC
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CC
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CC
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CC
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CC
         Name=3;
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CC
           Note=No experimental confirmation available;
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CC
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CC
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CC
            experimental confirmation available;
CC
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CC
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CC
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     -!- DOMAIN: The DHR-2 domain is necessary and sufficient for the GEF
CC
CC
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     -!- MISCELLANEOUS: 'Zizim' means 'spike' in Hebrew.
     -!- SIMILARITY: Belongs to the DOCK family.
CC
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CC
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CC
     -!- SIMILARITY: Contains 1 PH domain.
CC
CC
     Copyrighted by the UniProt Consortium, see http://www.uniprot.org/terms
CC
     Distributed under the Creative Commons Attribution-NoDerivs License
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          A Scan for Positively Selected Genes in the Genomes of Humans and
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  JOURNAL
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| Qу       | 721  | GACCACGATTCTCAAGCCTTCTGCCGATTTCCTCACCAGCAACAACTACTGAGGTACTC  | 780          |
| Db       | 2697 | GACCACGATTCTCAAGCCTTCTGCCGATTTCCTCACCAGCAACAACTACTGAAGTACTC  | 2756         |
| Qу       | 781  | ATGGTTTTTCTTTGATGTACTGATCAAATCTTTGGCTCAGCATTTGATAGAGAACTCCAA   | 840          |
| Db       | 2757 | ATGGTTTTTCTTTGATGTACTGATCAAATCTATGGCTCAGCATTTGATAGAGAACTCCAA   | 2816         |
| Qу       |      | AGTTAAGTTGCTGCGAAACCAGAGATTTCCTGCATCCTATCATCATGCAGCGGAAACCGT   |              |
| Db       |      | AGTTAAGTTGCTGCGAAACCAGAGATTTCCTGCATCCTATCATCATGCAGTGGAAACCGT   |              |
| Qу       |      | TGTAAATATGCTGATGCCACACATCACTCAGAAGTTTGGAGATAATCCAGAGGCATCTAA   |              |
| Db       |      | TGTAAATATGCTGATGCCACACATCACTCAGAAGTTTCGAGATAATCCAGAGGCATCTAA   |              |
| Qу       |      | GAACGCGAATCATAGCCTTGCTGTCTTCATCAAGAGATGTTTCACCTTCATGGACAGGGG   |              |
| Db       |      | GAACGCGAATCATAGCCTTGCTGTCTTCATCAAGAGATGTTTCACCTTCATGGACAGGGG   |              |
| Qу       |      | CTTTGTCTTCAAGCAGATCAACAACTACATTAGCTGTTTTGCTCCTGGAGACCCAAAGAC   |              |
| Db       |      | CTTTGTCTTCAAGCAGATCAACAACTACATTAGCTGTTTTGCTCCTGGAGACCCAAAGAC   |              |
| Qy       |      | CCTCTTTGAATACAAGTTTGAATTTCTCCGTGTAGTGTGCAACCATGAACATTATATTCC   |              |
| Db       |      | CCTCTTTGAATACAAGTTTGAATTTCTCCGTGTAGTGTGCAACCATGAACATTATATTCC   |              |
| Qy       |      | GTTGAACTTACCAATGCCATTTGGAAAAGGCAGGATTCAAAGATACCAAGACCTCCAGCT   |              |
| Db       |      | GTTGAACTTACCAATGCCATTTGGAAAAGGCAGGATTCAAAGATACCAAGACCTCCAGCT   |              |
| QУ       |      | TGACTACTCATTAACAGATGAGTTCTGCAGAAACCACTTCTTGGTGGGACTGTTACTGAG   |              |
| Db       |      | TGACTACTCATTAACAGATGAGTTCTGCAGAAACCACTTCTTGGTGGGACTGTTACTGAG   |              |
| Qу<br>Db |      | GGAGGTGGGACAGCCCTCCAGGAGTTCCGGGAGGTCCGTCTGATCGCCATCAGTGTGCT  |              |
|          |      | GGAGGTGGGGACAGCCCTCCAGGAGTTCCGGGAGGTCCGTCTGATCGCCATCAGTGTGCT   |              |
| ДУ       |      | CAAGAACCTGCTGATAAAGCATTCTTTTGATGACAGATATGCTTCAAGGAGCCATCAGGC   |              |
| Qy       |      | AAGGATAGCCACCCTCTACCTGCCTCTGTTTGGTCTGCTGATTGAAAACGTCCAGCGGAT   |              |
| Db       |      |  |              |
| Qy       |      | CAATGTGAGGGATGTCACCCTTCCCTGTGAACGCGGGCATGACCGTGAAGGATGAATC   |              |
| Db       |      | CAATGTGAGGGATGTCACCCTTCCCTGTGAACGCGGGCATGACCGTGAAGGATGAATC  CAATGTGAGGGATGTCACCCTTCCCTGTGAACGCGGGCATGACTGTGAAGGATGAATC |              |
| Qу       |      | CCTGGCTCTACCAGCTGTGAATCCGCTGGTGACGCCGCAGAAGGGAAGCACCCTGGACAA   |              |
| Db       |      |  |              |
| Qy       |      | CAGCCTGCACAAGGACCTGCTGGGCGCCATCTCCGGCATTGCTTCTCCATATACAACCTC 1   |              |
|          |      |  | <del>-</del> |

| Db        | 353  | 7 CAGCCTGCACAAGGACCTGCTGGGCGCCATCTCCGGCATTGCTTCTCCATATACAACCTC | 3596 |
|-----------|------|--|------|
| Qy        | 162  | AACTCCAAACATCAACAGTGTGAGAAATGCTGATTCGAGAGGATCTCTCATAAGCACAGA   | 1680 |
| Db        | 359  |  | 3656 |
| Qу        | 168  | L TTCGGGTAACAGCCTTCCAGAAAGGAATAGTGAGAAGAGCAATTCCCTGGATAAGCACCA | 1740 |
| Db        | 3657 | TTCGGGTAACAGCCTTCCAGAAAGGAATAGTGAGAAGACAATTCCCTGGATAAGCACCA    | 3716 |
| Qy        | 1741 | ACAAAGTAGCACATTGGGAAATTCCGTGGTTCGCTGTGATAAACTTGACCAGTCTGAGAT   | 1800 |
| Db        | 3717 | ACAAAGTAGCACATTGGGAAATTCCGTGGTTCGCTGTGATAAACTTGACCAGTCTGAGAT   | 3776 |
| Qу        | 1801 | TAAGAGCCTACTGATGTGTTTCCTCTACATCTTAAAGAGCATGTCTGATGATGCTTTGTT   | 1860 |
| Db        | 3777 | * TAAGAGCCTACTGATGTTTCCTCTACATCTTAAAGAGCATGTCTGATGATGCTTTGTT   | 3836 |
| Qy        | 1861 | TACATATTGGAACAAGGCTTCAACATCTGAACTTATGGATTTTTTTACAATATCTGAAGT   | 1920 |
| Db        | 3837 | TACATATTGGAACAAGGCTTCAACATCTGAACTTATGGATTTTTTTACAATATCTGAAGT   | 3896 |
| QУ        | 1921 | CTGCCTGCACCAGTTCCAGTACATGGGGAAGCGATACATAGCCAGGAACCAGGAGGGGTT   | 1980 |
| Db        | 3897 | CTGCCTGCACCAGTTCCAGTACATGGGGAAGCGATACATAGC                     | 3938 |
| Qy        | 1981 | GGGACCCATAGTTCATGATCGAAAGTCTCAGACATTGCCTGTTTCCCGTAACAGAACAGG   |      |
| Db        | 3939 | CAGAACAGG  | 3947 |
| Qy        | 2041 | AATGATGCATGCCAGATTGCAGCAGCTGGGCAGCCTGGATAACTCTCTCACTTTTAACCA   | 2100 |
| Db        | 3948 | AATGATGCATGCCAGATTGCAGCAGCTGGGCAGCCTGGATAACTCTCTCACTTTTAACCA   | 4007 |
| Qy        | 2101 | CAGCTATGGCCACTCGGACGCAGATGTTCTGCACCAGTCATTACTTGAAGCCAACATTGC   | 2160 |
| Db        | 4008 | CAGCTATGGCCACTCGGACGCAGATGTTCTGCACCAGTCATTACTTGAAGCCAACATTGC   | 4067 |
| Qy        | 2161 | TACTGAGGTTTGCCTGACAGCTCTGGACACGCTTTCTCTATTTACATTGGCGTTTAAGAA   | 2220 |
| Db        | 4068 | TACTGAGGTTTGCCTGACAGCTCTGGACACGCTTTCTCTATTTACATTGGCGTTTAAGAA   | 4127 |
| Qу        |      | CCAGCTCCTGGCCGACCATGGACATAATCCTCTCATGAAAAAAGTTTTTGATGTCTACCT   |      |
| Db        |      | CCAGCTCCTGGCCGACCATGGACATAATCCTCTCATGAAAAAAGTTTTTGATGTCTACCT   |      |
| Qу        |      | GTGTTTTCTTCAAAAACATCAGTCTGAAACGGCTTTAAAAAATGTCTTCACTGCCTTAAG   |      |
| Db        |      | GTGTTTTCTTCAAAAACATCAGTCTGAAACGGCTTTAAAAAATGTCTTCACTGCCTTAAG   |      |
| Qy        |      | GTCCTTAATTTATAAGTTTCCCTCAACATTCTATGAAGGGAGAGCGGACATGTGTGCGGC   |      |
| Db        |      | GTCCTTAATTTATAAGTTTCCCTCAACATTCTATGAAGGGAGAGCGGACATGTGTGCGGC   |      |
| Qу        |      | TCTGTGTTACGAGATTCTCAAGTGCTGTAACTCCAAGCTGAGCTCCATCAGGACGGAGGC   |      |
| Db        |      | TCTGTGTTACGAGATTCTCAAGTGCTGTAACTCCAAGCTGAGCTCCATCAGGACGGAGGC   |      |
| Qy        |      | CTCCCAGCTGCTCTACTTCCTGATGAGGAACAACTTTGATTACACTGGAAAGAAGTCCTT   |      |
| Db        |      | CTCCCAGCTGCTCTACTTCCTGATGAGGAACAACTTTGATTACACTGGAAAGAAGTCCTT   |      |
| Qу        |      | TGTCCGGACACATTTGCAAGTCATCATATCTGTCAGCCAGC                      |      |
| Db        |      | TGTCCGGACACATTTGCAAGTCATCATATCTGTCAGCCAGC                      |      |
| Qy<br>Di- |      | CATTGGGGAAACCAGATTCCAGCAGTCCCTGTCCATCATCAACAACTGTGCCAACAGTGA   |      |
| Db        |      | CATTGGGGGAACCAGATTCCAGCAGTCCCTGTCCATCATCAACAACTGTGCCAACAGTGA   |      |
| Qy<br>Db  |      | CCGGCTTATTAAGCACACCAGCTTCTCCTCTGATGTGAAGGACTTAACCAAAAGGATACG   |      |
| Db<br>Ov  |      | CCGGCTTATTAAGCACCAGCTTCTCCTCTGATGTGAAGGACTTAACCAAAAGGATACG     |      |
| Qу        | 2/01 | CACGGTGCTAATGGCCACCGCCCAGATGAAGGAGCATGAGAACGACCCAGAGATGCTGGT 2 | 2760 |

| Db | 4608 | 3 CACGGTGCTAATGGCCACCGCCCAGATGAAGGAGCATGAGAACGACCCAGAGATGCTGGT       | 4667 |
|----|------|--|------|
| Qy | 2761 | GGACCTCCAGTACAGCCTGGCCAAATCCTATGCCAGCACGCCCGAGCTCAGGAAGACGTG         | 2820 |
| Db | 4668 | GGACCTCCAGTACAGCCTGGCCAAATCCTATGCCAGCACGCCCGAGCTCAGGAAGACGTG         | 4727 |
| Qу | 2821 | GCTCGACAGCATGGCCAGGATCCATGTCAAAAATGGCGATCTCTCAGAGGCAGCAATGTG         | 2880 |
| Db | 4728 | GCTCGACAGCATGGCCAGGATCCATGTCAAAAATGGCGATCTCTCAGAGGCAGCAATGTG         | 4787 |
| Qу | 2881 | CTATGTCCACGTAACAGCCCTAGTGGCAGAATATCTCACACGGAA                        | 2925 |
| Db | 4788 |  | 4847 |
| Qy | 2926 | AGGCGT   | 2931 |
| Db | 4848 | GGAGCCGCCCTTCTCCCCCACAGCCATAGCGCCTGCCTGAGGAGGAGCCGGGGAGNNNN          | 4907 |
| Qу | 2932 | ${\tt GTTTAGACAAGGATGCACCGCCTTCAGGGTCATTACCCCAAACATCGACGAGGAGGCCTC}$ | 2991 |
| Db | 4908 | инипипипипипипипипипипипипипипипипипипи                              | 4967 |
| Qy | 2992 | CATGATGGAAGACGTGGGGATGCAGGATGTCCATTTCAACGAGGATGTGCTGATGGAGCT         | 3051 |
| Db | 4968 |  | 5027 |
| Qy | 3052 | CCTTGAGCAGTGCGCAGATGGACTCTGGAAAGCCGAGCGCTACGAGCTCATCGCCGACAT         | 3111 |
| Db | 5028 | CCTTGAGCAGTGCGCAGATGGACTCTGGAAAGCCGAGCGCTACGAGCTCATCGCCGACAT         | 5087 |
| Qу | 3112 | CTACAAACTTATCATCCCCATTTATGAGAAGCGGAGGGAT                             | 3151 |
| Db | 5088 | CTACAAACTTATCATCCCCATTTATGAGAAGCGGAGGGATTTTGAGAGGCTGGCCCATCT         | 5147 |
| Qy | 3152 |  | 3151 |
| Db | 5148 | ${\tt GTATGACACGCTGCACCGGGCCTACAGCAAAGTGACCGAGGTCATGCACTCGGGCCGCAG}$ | 5207 |
| Qy | 3152 |  | 3151 |
| Db | 5208 | ${\tt GCTTCTGGGGACCTACTTCCGGGTAGCCTTCTTCGGGCAGCAATACCAGTTTACAGACAG$  | 5267 |
| Qy | 3152 | TTCTTTGAAGATGAAGATGGAAAGGAGTATATTTACAAGGA                            | 3192 |
| Db | 5268 |  | 5327 |
| Qу | 3193 | ACCCAAACTCACACCGCTGTCGGAAATTTCTCAGAGACTCCTTAAACTGTACTCGGATAA         | 3252 |
| Db | 5328 | ACCCAAACTCACACCGCTGTCGGAAATTTCTCAGAGACTCCTTAAACTGTACTCGGATAA         | 5387 |
| Qу | 3253 | ATTTGGTTCTGAAAATGTCAAAATGATACAGGATTCTGGCAAGGTCAACCCTAAGGATCT         | 3312 |
| Db | 5388 | ATTTGGTTCTGAAAATGTCAAAATGATACAGGATCTGGCAAGGTCAACCCTAAGGATCT          | 5447 |
| Qу | 3313 | GGATTCTAAGTATGCATACATCCAGGTGACTCACGTCATCCCCTTCTTTGACGAAAAAGA         | 3372 |
| Db | 5448 | GGATTCTAAGTATGCATACATCCAGGTGACTCACGTCATCCCCTTCTTTGACGAAAAAGA         | 5507 |
| Qу | 3373 | GTTGCAAGAAAGGAAAACAGAGTTTGAGAGATCCCACAACATCCGCCGCTTCATGTTTGA         | 3432 |
| Db | 5508 | GTTGCAAGAAAGGAAAACAGAGTTTGAGAGATCCCACAACATCCGCCGCTTCATGTTTGA         | 5567 |
| Qу | 3433 | GATGCCATTTACGCAGACCGGGAAGAGGCAGGCCGGGGTGGAAGAGCAGTGCAAACGGCG         | 3492 |
| Db | 5568 | GATGCCATTTACGCAGACCGGGAAGAGGCAGGCGGGGGGGG                            | 5627 |
| Qу | 3493 | CACCATCCTGACAGCCATACACTGCTTCCCTTATGTGAAGAAGCGCATCCCTGTCATGTA         | 3552 |
| Db | 5628 |  | 5687 |
| Qy | 3553 | CCAGCACCACACTGACCTGAACCCCATCGAGGTGGCCATTGACGAGATGAGTAAGAAGGT         | 3612 |
| Db | 5688 | CCAGCACCACACTGACCTGAACCCCATCGAGGTGGCCATTGACGAGATGAGTAAGAAGGT         | 5747 |
| Qу | 3613 | GGCGGAGCTCCGGCAGCTGTGCTCCTCGGCCGAGGTGGACATGATCAAACTGCAGCTCAA         | 3672 |

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Db
      5748 GGCGGAGCTCCGGCAGCTGTGCTCCTCGGCCGAGGTGGACATGATCAAACTGCAGCTCAA 5807
      3673 ACTCCAGGGCAGCGTGAGTGTTCAGGTCAATGCTGGCCCACTAGCATATGCGCGAGCTTT 3732
Qу
         5808 ACTCCAGGGCAGCGTGAGTGTTCAGGTCAATGCTGGCCCACTAGCATATGCGCGAGCTTT 5867
Db
Qу
      3733 CTTAGATGATACAAACACAAAGCGATATCCTGACAATAAAGTGAAGCTGCTTAAGGAAGT 3792
         5868 CTTAGATGATACAAACACAAAGCGATATCCTGACAATAAAGTGAAGCTGCTTAAGGAAGT 5927
      Qу
         Db
Qy
      3853 AGAAGACCAGCTCGAGTATCAGGAAGAAATGAAAGCCAACTACAGGGAAATGGCGAAGGA 3912
         Db
      5988 AGAAGACCAGCTCGAGTATCAGGAAGAAATGAAAGCCAACTACAGGGAAATGGCGAAGGA 6047
      3913 GCTTTCTGAAATCATGCATGAGCAGATCTGCCCCCTGGAGGAGAAGACGAGCGTCTTACC 3972
Qу
         Db
      6048 GCTTTCTGAAATCATGCATGAGCAGATCTGCCCCCTGGAGGAGAAGACGAGCGTCTTACC 6107
Qy
      3973 GAATTCCCTTCACATCTTCAACGCCATCAGTGGGACTCCAACAAGCACAATGGTTCACGG 4032
         6108 GAATTCCCTTCACATCTTCAACGCCATCAGTGGGACTCCAACAAGCACAATGGTTCACGG 6167
      4033 GATGACCAGCTCGTCTTCGGTCGTGTGA 4060
Qу
         11111111111111111111111111111111
Db
     6168 GATGACCAGCTCGTCTTCGGTCGTGTGA 6195
<!--EndFragment-->
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